

REMARKS

At the time of the First Office Action dated February 24, 2009, claims 1-12 were pending and rejected in this application. Claims 2 and 10 were objected to for failing to end in a period. Applicants have amended claims 1 and 9 to include the limitations of claims 2 and 10, respectively, and canceled claims 2 and 10 to overcome the Examiner's objection.

CLAIMS 1-5 ARE REJECTED UNDER 35 U.S.C. § 101

In paragraphs 6-8 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-5, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

Although Applicants disagree with the Examiner's implied assertion that independent claim 1 is not directed to statutory subject matter, independent claim 1 has been amended to recite a "computer-implemented method for selectively applying course content updates in a learning management system." As such, at the very least, independent claim 1 is tied to a machine and meets the 'machine or transformation' test described within *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008) (en banc). Applicants respectfully submit that claim 1 (and those claims dependent upon claim 1) are directed to statutory subject matter within the meaning of 35 U.S.C. § 101.

For the reasons submitted above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-5 under 35 U.S.C. § 101.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on pages 5 and 6 of the First Office Action, the Examiner appears to be employing rationale (G). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. As such, Applicants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Upon reviewing the Examiner's analysis in view of the requirements discussed above necessary for the Examiner to establish a prima facie case of obviousness, Applicants recognize numerous deficiencies in the Examiner's analysis.

Claim 1

Amended independent claim 1 recites “determining whether to wholly reject said course metadata update to said associated course master, or to apply said course metadata update to said associated course master.” With regard to these limitations, the Examiner asserted the following in paragraph 15 of the First Office Action:

determining whether to wholly reject said course metadata update to said associated course master, or to apply said course metadata update to said associated course master; (P[00850086]: updates are not applied if errors exist and updates are reviewed to determine whether to apply or not.) (emphasis in original)

Applicants disagree with the Examiner's characterization of the scope and content of Stirpe. Additionally, Applicants note that the Examiner has failed to consider (and or construe) the language of the claims – specifically, "associated" and "course master." In this regard, the Examiner is referred to paragraphs [0014] and [0023] of Applicants' specification regarding the term "course master."

The passage cited by the Examiner does not refer to “course master” or “associated”. Instead, Stirpe describes an institution transmitting a “document” to the knowledge exchange system after authentication of the sender and decryption of the document. In that sense, the document is not associated with a course master nor does the “document” of Stirpe provide for a course metadata update to the associated course master. Instead, Stirpe merely provides for the transmission of a document. Thus, the Examiner has mischaracterized the scope and content of Stirpe.

Independent claim 1 further recites "further determining whether to apply said course metadata update to existing course offerings based upon said associated course master, or whether to exempt said existing course offerings from said course metadata update," which the

Examiner also treated in the above-reproduced passage. Upon reviewing the Examiner's cited teachings within Stirpe, Applicants are entirely unclear where Stirpe teaches that a step of determining (i.e., making a determination) that the "associated course master" is to have the course metadata updated or whether to exempt the existing course offerings from the metadata update. The concept of making the determination to the "associated course master" is absent from the Examiner's cited passages. As such, the Examiner has again mischaracterized the scope and content of Stirpe.

The Examiner further presented the following obviousness analysis in paragraph 14 of the First Office Action:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included separately updating metadata from content, as disclosed by Menon in the system disclosed by Stirpe, for the motivation of providing a method of lowering the costs associated with distributing content using bandwidth. (Menon; P[0024] and [0034]).

Applicants are unclear as to the relevancy of the Examiner's analysis. The distributed provision of services of Menon does not appear to have any relevancy to making a determination that an associated course master exists or modifying Stirpe to include this limitation. The Examiner's assertion that "a method of lowering the costs associated with distributing content using bandwidth ..." is wholly absent from paragraphs [0024] and [0034] and instead merely raises the question of "storage vs. bandwidth" and therefore fails to a realistic benefit for modifying Stirpe in view of Menon.

Claim 3

Dependent claim 3 recites "performing said identifying, determining and further determining steps only where said comparison indicates that said course package incorporates

said update.” With regard to these limitations, the Examiner asserted the following in paragraph 16 of the First Office Action:

comparing said identifier with other identifiers associated with existing course masters disposed within the learning management system; and, (P[0086]: updates are selectively applied, thus the comparison of identifiers is inherent in the selective updating process.)

performing said identifying, determining and further determining steps only where said comparison indicates that said course package incorporates said update. (P[0086]: updates are selectively applied, thus the comparison of identifiers is inherent in the selective updating process. (emphasis in original)

Applicants disagree with the Examiner's characterization of the scope and content of Stirpe.

Additionally, Applicants note that the Examiner has failed to consider (and or construe) the language of the claims – specifically, "existing" and "course master." In this regard, the Examiner is referred to paragraphs [0014] and [0023] of Applicants' specification regarding the term "course master."

More importantly, the Examiner's reliance upon the doctrine of inherency to teach the limitations at issue is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.¹ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.² However, the Examiner did not discharge the burden of indicating where such a teaching appears in the prior art. Thus, the Examiner has not established that this limitation is inherently disclosed by Stirpe.

¹ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

² *Finnegan Corp. v. ITC*, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ 2d 1746 (Fed. Cir. 1991); *Ex parte Levy*, 17 USPQ2d 1461 (BPAI 1990).

1 For the above-described reasons, the Examiner has failed to establish that the claimed
2 invention, as recited in claims 1, 3-9, 11 and 12, , would have been obvious within the meaning of
3 35 U.S.C. § 103. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of
4 claims 1, 3-9, 11 and 12 under 35 U.S.C. § 103 for obviousness based upon Stirpe and Menon.
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Applicants have made every effort to present claims, which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Respectfully submitted,

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